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09/894,108

06/28/2001

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EXAMINER

DENNISON, JERRY B

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DWIP N. BANERJEE and RABINDRANATH DUTTA

Appeal 2008-2668¹
Application 09/894,108
Technology Center 2400

Decided: June 23, 2009²

Before JEAN R. HOMERE, JOHN A. JEFFERY, and STEPHEN C. SIU,
Administrative Patent Judges.

HOMERE, *Administrative Patent Judge.*

¹ Filed June 28, 2001. The real party in interest is IBM Corp.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1 through 7, 9, 11 through 19, 21 through 40, and 42 through 48. Claims 8, 10, 20, and 41 have been cancelled. Claim 15 has been deemed to be allowable if rewritten in independent form to include the limitations of their respective base claims and any other intervening claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' Invention

As depicted in Figure 1, Appellants invented a method and system for managing a subscriber's access to an online subscription service. (Spec. 2: 24-25.) In particular, the subscriber is provided with full access to online content during the subscription period. After the subscription period expires, the subscriber's access to the online content is gradually reduced until all access is terminated or full access is restored upon the subscriber renewing his/her subscription. (Spec. 3: 1-21.)

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method to be executed by one or more processors for managing subscriber access to online subscription content comprising:
 - (a) providing the subscriber with access to the online subscription service at a first level of service during a subscription period; and

(b) after expiration of the subscription period, providing the subscriber with access to the online subscription service at a level of service that is lower than the first level of service during a post-expiration period; and then

(c) terminating subscriber access to the online subscription service after the post-expiration period unless the subscription is renewed.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Drosset	US 6,662,231	Dec. 9, 2003
Nye	US 2003/0028548	Feb. 6, 2003
Davis	US 2002/0040395	Apr. 4, 2002

Rejections on Appeal³

The Examiner rejected the claims on appeal as follows:

1. Claims 1 through 7, 9, 11 through 14, 33 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Drosset and Nye.

2. Claims 21, 22, 29 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Drosset, Nye, and Davis.

³ The Examiner summarily rejected claims 16 through 19, 23 through 28, 30 through 32, 34 through 40, 42 through 45, and 47 without properly setting out a statement of rejection that clearly identifies the references relied upon to reject these claims.

Appellants' Contentions

Appellants contend that the combination of Drosset and Nye does not render the claimed invention unpatentable. (App. Br. 8-10.) According to Appellants, the proffered combination is limited to downgrading a subscriber's membership level from paying to non-paying status. However, Appellants contend that it does not teach terminating the subscriber's access to the online content after the post expiration period of his/her subscription, as recited in independent claim 1. (*Id.*)

Examiner's Findings

The Examiner finds that Drosset's disclosure of preserving a subscriber's information for a period of time after being downgraded from paying to non-paying status teaches or suggests that when the information is ultimately deleted, the subscriber's access is terminated. (Ans. 12.) Further, the Examiner finds that Nye complements Drosset by disclosing that after the expiration of a subscriber's subscription, the subscription is cancelled by purging the subscriber's information from the database. (Ans. 12-13.)

II. ISSUE

Have Appellants shown that the Examiner erred in concluding that the combination of Drosset and Nye renders claim 1 unpatentable? In particular, the issue turns on whether the cited combination fairly teaches or

suggests terminating a subscriber's access to an online subscription content after a post termination period expires.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Drosset

1a. Drosset discloses a subscriber-based audio service for providing audio files access to client devices connected to a server over a communication network. (Col. 2, ll. 38-41.)

1b. Upon authenticating the subscriber, the server determines whether the subscriber is a paying or a non-paying member in order to provide the subscriber with a corresponding level of access to audio file contents. (Col. 13, ll. 53-62, col. 16, ll. 10-16.)

1c. Drosset discloses that, upon a paying member downgrading his/her membership to non-paying status, the user's access is reduced, and the user's information is preserved for period of time with the expectation that the membership will be upgraded back to paying status with full access privileges. (Col. 15, ll. 41-57.)

Nye

2. Nye discloses a database for managing a subscriber's information relating to particular services. When a subscriber cancels subscription to a service, the subscriber's name is removed from the list of

active customers and placed on the list of inactive customers. (P. 4, para. [0044-0046].)

IV. PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

V. ANALYSIS

Independent claim 1 requires, in relevant part, terminating a subscriber's access to an online subscription content after a post termination period expires. As set forth in the Findings of Facts section, Drosset discloses that, upon downgrading a subscriber's membership from paying to non-paying status, the subscriber's access to online audio file contents is reduced. (FF. 1a, 1b.) Drosset further discloses that the subscriber's information is preserved for a period of time after the subscription lapses to facilitate the subscriber's reinstatement to full access upon upgrading the subscriber's membership back to paying status. (FF. 1c.)

We agree with the Examiner that Drosset's disclosure teaches or suggests that after the post termination period expires, the subscriber's

membership information is deleted from the database. However, we do not agree with the Examiner that such deletion of the subscriber information in any way teaches or suggests that the user's access to the online audio files is terminated. While it is possible that, upon such deletion, the subscriber's access to the online content might eventually be terminated, it is not the only outcome that might ensue therefrom. Beyond the disclosure of reducing the subscriber's level of access to the audio file content, Drosset is simply silent as to what actually happens to the user's access when the membership information is deleted. Further, we agree with Appellants that Nye's disclosure does not cure these deficiencies. While Nye discloses purging a subscriber's information from a database upon canceling a related subscription (FF. 2), it is, however, silent on whether the subscriber's access is also terminated at such time. Therefore, Appellants have shown that the Examiner erred in concluding that the combination of Drosset and Nye renders independent claim 1 unpatentable.

Because claims 2 through 7, 9, 11 through 19, 21 through 40, and 42 through 48 recite these same limitations, Appellants have shown error in the Examiner's rejection of those claims.

CONCLUSION OF LAW

Appellants have established that the Examiner erred in rejecting claims 1 through 7, 9, 11 through 19, 21 through 40, and 42 through 48 as being unpatentable under 35 U.S.C. § 103(a).

Appeal 2008-2668
Application 09/894,108

DECISION

We reverse the Examiner's rejection of claims 1 through 7, 9, 11 through 19, 21 through 40, and 42 through 48.

REVERSED

PEB

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